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Dated: September 24, 2003

Signature:

(Tamara Alcaraz)

Docket No.: 213542000101
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent Application of:

Lennart OLSSON and Tatjana NARANDA

Application No.: 09/991,548

Group Art Unit: 1644

Filed: November 20, 2001

Examiner: M. Dibrino

For: RECEPTOR DERIVED PEPTIDES AS
MODULATORS OF RECEPTOR ACTIVITY

TECH CENTER 1600/2900

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Office Action dated March 25, 2003 (Paper No. 12), which set forth a restriction requirement for pending claims 8, 9 and 37-46. A response was due April 24, 2003; a five month extension of time is also requested, extending the time for response from April 24, 2003 to September 24, 2003. Accordingly this response is timely filed.

The Examiner has required restriction between

- I. Claim 8, 9, 37-40, 42, 44 and 46
- II. Claim 8, 9, 37-39, 41, 42, 44 and 46
- III. Claims 37-40, 43, 45 and 46
- IV. Claims 37-39, 41, 43, 45 and 46

Applicants respectfully traverse this requirement.

(1) The requirement is improper as a matter of law and must be withdrawn. It is well established that the Office *may not* restrict a single claim into multiple inventions. See *In re Weber*:

An applicant has a right to have each claim examined on the merits ... [and] in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification ... [A] rejection under § 121 [restriction practice] violates the basic right of the applicant to claim his invention as he chooses. *In re Weber*, 580 F.2d 455, 458-59 (CCPA 1978).

In the present Office Action *each and every* claim is restricted into multiple groups. Applicants respectfully request that the restriction requirement be withdrawn, and that the intact claims be considered on their merits.

(2) Further, Applicants submit there would be no burden on the Office to examine all claims in one application. MPEP § 803 states, "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." (Emphasis added.) The lack of burden is evidenced, *inter alia*, by the fact that all groups include claims that are either the same or depend from claims that are same. (Applicants respectfully submit that the class and subclass designated for each group do not seem to relate to any distinction between the subject matter of the claims. For example, Applicants do not understand how the distinction between the class of Group 1 [514/2 DESIGNATED ORGANIC ACTIVE INGREDIENT CONTAINING (DOAI) Peptide containing (e.g., protein, peptones, fibrinogen, etc.) DOAI] and Group 2 [424/185.1 DRUG, BIO-AFFECTING AND BODY TREATING COMPOSITIONS: Amino acid sequence disclosed in whole or in part; or conjugate, complex, or fusion protein or fusion polypeptide including the same] relates to any differences in the subject matter of the claims of the two groups. The distinctions between the other classifications seem similarly unrelated to the subject matter. Applicants respectfully request clarification and would be happy to discuss the subject matter of the claims with the Examiner.)

Applicants submit that, at minimum, Groups 1 and 2 should be rejoined. Because the restriction requirement is not proper as a matter of law, and because searching all of the claims together would not be a serious burden to the Office, Applicants respectfully traverse. Applicants' election with traverse is to Group 1. Species election: The Office required a 3-way species election. For A, Applicants elect EPO Receptor. The Office states that "the application contains claims directed to the following patentably distinct species . . . an exogenous compound, one of SEQ ID NOS:1-44 . . . an exogenous ligand, one of SEQ ID NOS:1-44." Examples of exogenous compounds are described in the specification at page 35, first paragraph. For purposes of this response, Applicants elect SEQ ID NO: 11 (QRVEILEGRTECVLSNLRGRTRY). SEQ ID NOS:1-44 are not exogenous ligands and it is not clear how any species election is to be made. For EPO receptor, an example of an exogenous ligand would be erythropoietin.

The following claims are believed to read on the elected species: 8-9, 37-40, 42, 44, and 46. Applicant requests examination of the elected subject matter on the merits.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 213542000101. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: September 24, 2003

Respectfully submitted,

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